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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/967,090	09/27/2001	George C.K. Chen	60617.300501	6634

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INTELLECTUAL PROPERTY LAW OFFICE
1901 S. BASCOM AVENUE, SUITE 660
CAMPBELL, CA 95008

EXAMINER

CHANG, AUDREY Y

ART UNIT	PAPER NUMBER
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2872

DATE MAILED: 10/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/967,090

Applicant(s)

CHEN, GEORGE C.K.

Examiner

Audrey Y. Chang

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 September 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Remark

- This Office Action is in response to applicant's amendment filed on July 28, 2003, which has been entered as paper number 8.
- By this amendment, the applicant has amended claims 2, 3, and 11. The applicant is respectfully noted that the *amendments* to the *specification* and the *abstract* are not complied with the rule they are therefore NOT ENTERED.
- Claims 1-14 remain pending in this application.
- The objections to the drawings set forth in the previous Office Action dated May 21, 2003 still HOLDS.
- The objections to the specification set forth in the previous Office Action still HOLDS.
- The objections to the claims set forth in the previous Office Action are withdrawn in response to applicant's amendment.
- The rejections to the claims under 35 USC 112, first paragraph, set forth in the previous Office Action are withdrawn in response to applicant's amendment.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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2. **Claims 1, 4, 5, 6, 9, 10, 13, and 14 rejected under 35 U.S.C. 102(e) as being anticipated by the patent issued to Ip (PN. 6,141,130).**

The reasons for rejection are set forth in the previous Office Action dated May 21, 2003.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 2-3 and 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over the patent issued to Ip in view of the Japanese Patent Tachikawa et al (JP401250833A).**

The reasons for rejection are set forth in the previous Office Action dated May 21, 2003.

5. **Claims 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over the patent issued to Ip in view of the Japanese Patent Tachikawa et al (JP401250833A).**

The reasons for rejection are set forth in the previous Office Action dated May 21, 2003.

Double Patenting

- The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. **Claims 1-14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 9, 12-16 and 22 of U.S. Patent No. 6,552,856.**

The reasons for rejection are set forth in the previous Office Action dated May 21, 2003.

Response to Arguments

7. Applicant's arguments filed on July 28, 2003 have been fully considered but they are not persuasive.

8. In response to applicant's arguments which state the cited Ip reference **only** teaches to tune the etalon by either changing the effective distance or spacing between the two reflective plates or by changing the angle of incident of the light beam and has not taught to tune the etalon by changing refractive index of the gas medium within etalon, therefore differs from the instant application, the examiner respectfully *disagrees* for the reasons stated below. The examiner respectfully directs the applicant's attention to the **paragraph** in column 5 lines 19-40 of the cited Ip reference. It reads *specifically*, "The cavity 15 in *alternative* embodiments of the invention can contain air or another light transmissive medium having a different refraction coefficient than air such as glass, liquid crystal or **sealed gas**. In *embodiment* wherein air or another gas is used in the gap between the reflective surfaces 13 and 14, a **change in density or composition**- due to changes in **pressure, temperature, or humidity**, will affect the **refractive index** of the air or other gas, *affecting* the **resonance** and anti-resonance wavelength." The cited reference *specifically teaches* that the by **changing the refractive index** of the gas in the cavity, either by changing density or composition of the gas, the **resonance** condition of the cavity change. **Resonance condition** is the crucial condition and the **only** condition matters for defining and tuning an etalon. This reference therefore reads on and meets the claims of the instant application.

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The paragraph concerning sealing the gas is for preventing wavelength drifting which means to stabilize the etalon resonance condition once the tuning is done. Furthermore, the idea of tuning an etalon by changing refractive index of the gas filling the cavity of the etalon is *extremely well known in the art*. For instance, US patent issued to **Basting et al** teaches specifically a pressure-tuned etalon (6, Figure 4) wherein the etalon is tuned by changing the refractive index of the gas within the cavity of the etalon via changing the pressure of the cavity or medium, (please see column 7). This idea therefore is not a patentable idea.

9. The applicant is respectfully noted that in the remark filed on July 28, 2003, it seems a Terminal Disclaimer is submitted, however **no such document** are found in applicant's response. The double patenting rejection therefore still holds.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US patent issued to **Basting et al** (PN. 6,154,470) teaches to tune the etalon by varying the pressure therefore the refractive index of the gas within the etalon cavity.

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

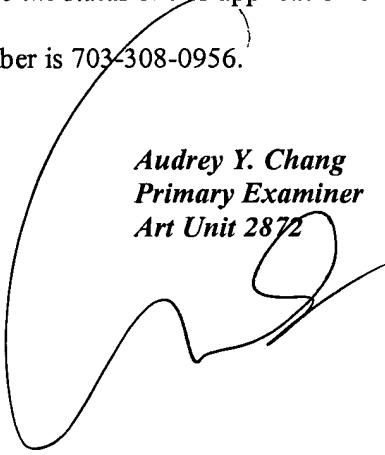
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Audrey Y. Chang whose telephone number is 703-305-6208. The examiner can normally be reached on Monday-Friday (8:00-4:30), alternative Mondays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached on 703-305-0024. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

Audrey Y. Chang
Primary Examiner
Art Unit 2872



A. Chang, Ph.D.